

REMARKS

Claims 1-20 are pending in the present application. The Office Action and cited references have been considered. Favorable reconsideration is respectfully requested.

The Office Action states that the amendments to the specification filed on March 5, 2008, have been entered. However, the record on Private PAIR states that the specification has not been entered. Correction is respectfully requested.

Claim 11 was objected to as being dependent upon itself. This typographical error has been corrected. Withdrawal of this objection is respectfully requested. Additionally, Applicant has noticed, and corrected, some antecedent basis and grammatical informalities in the claims. Applicant submits that these changes are not narrowing amendments and do not affect the scope of the claims.

Claims 1-9 and 18-19 were rejected under 35 U.S.C. § 103 as being unpatentable over Hultgren (U.S. Patent No. 6,868,391) in view of Stewen (WO 99/22346). Claims 10-17 and 20 were rejected under 35 U.S.C. § 103 as being unpatentable over Hultgren in view of Stewen and further in view of "Official Notice". These rejections are respectfully traversed for the following reasons.

Claim 1 recites a method for controlling and operating a vending machine that incorporates a mobile radiocommunication transmit/receive unit and can be called from a user's mobile telephone unit over a mobile telephone network via an abbreviated mobile telephone number affixed on the vending machine. The method comprises, upon

receipt of a call from the user's mobile telephone unit to the abbreviated mobile telephone number on the vending machine, establishing a connection to a bank and determining if the user has an account at that bank, and if so, whether there are sufficient funds in the user's account, if the user has an account and there are sufficient funds, prompting, via the vending machine, the user to select a merchandise item, after the merchandise item has been dispensed, generating, a billing entry in the vending machine, and settling the billing entry via a payment gateway, the step of settling comprising accessing a mini-payment account the user has opened with a bank, determining the mini-payment account number based on the user's mobile telephone number, and issuing a request, with a reference to the vending machine, to reserve a certain maximum amount from the account of the user who has been uniquely identified based on his telephone number. Claim 1 is considered exemplary of the other independent claims 10 and 18. Claims 1 and 18 have been amended to include the limitation that a request is issued, with a reference to the vending machine, to reserve a certain maximum amount from the account of the user who has been uniquely identified based on his telephone number (claim 10 already contained such a limitation). The claimed combination, as reflected in claims 1, 10, and 18, is not taught, disclosed or made obvious by the prior art of record.

The Examiner has used the Hultgren patent as a primary reference, alleging that Hultgren teaches everything but "the controlling and operating a *vending machine* from a mobile telephone." Applicant respectfully disagrees.

Applicant notes the use of the following allegations in the rejection:

(due to claim language, these limitations are not required since the prior art teaches the scenario when the customer does not have sufficient funds, see column 7, lines 39-47).

The meaning of this allegation, which appears with respect to no less than 15 claim paragraphs in the rejection, including entire claims, is not clear. Limitations of the claims cannot be ignored or simply be pronounced "not required". If the Examiner is asserting that the claim limitations are inherent in the prior art, he should say so. Assuming for this response that this is the Examiner's meaning, Applicant respectfully submits that the Examiner has not made out a *prima facie* case of inherency. Reference is made to MPEP 2112 IV., which states:

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted) (The claims were drawn to a disposable diaper having three fastening elements. The reference disclosed two fastening elements that could perform the same function as the three fastening elements in the claims. The court construed the claims to require three separate elements and held that the reference did not

disclose a separate third fastening element, either expressly or inherently.). Also, "[a]n invitation to investigate is not an inherent disclosure" where a prior art reference "discloses no more than a broad genus of potential applications of its discoveries." *Metabolite Labs., Inc. v. Lab. Corp. of Am. Holdings*, 370 F.3d 1354, 1367, 71 USPQ2d 1081, 1091 (Fed. Cir. 2004) (explaining that "[a] prior art reference that discloses a genus still does not inherently disclose all species within that broad category" but must be examined to see if a disclosure of the claimed species has been made or whether the prior art reference merely invites further experimentation to find the species.

In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original) (Applicant's invention was directed to a biaxially oriented, flexible dilation catheter balloon (a tube which expands upon inflation) used, for example, in clearing the blood vessels of heart patients). The examiner applied a U.S. patent to Schjeldahl which disclosed injection molding a tubular preform and then injecting air into the preform to expand it against a mold (blow molding). The reference did not directly state that the end product balloon was biaxially oriented. It did disclose that the balloon was "formed from a thin flexible inelastic, high tensile strength, biaxially oriented synthetic plastic material." *Id.* at 1462 (emphasis in original). The examiner argued that Schjeldahl's balloon was inherently biaxially oriented. The Board reversed on the basis that the examiner did not provide objective evidence or cogent technical reasoning to support the conclusion of inherency.). (Emphasis in original.)

If this rejection is maintained, the Examiner is requested to particularly point out where in the cited patents ***each*** limitation in the rejected claims are found. Absent such an explanation, the rejection is believed to be improper and should be withdrawn.

Turning now to the specifics of the rejection, the Examiner asserts that the limitations “establishing a connection to a bank and determining if the user has an account at that bank, and if so, whether there are sufficient funds in the user’s account, if the user has an account and there are sufficient funds, prompting, via the vending machine, the user to select a merchandise item, after the merchandise item has been dispensed, generating a billing entry in the vending machine, and settling the billing entry via a payment gateway, the step of settling comprising accessing a mini-payment account the user has opened with a bank, and determining the mini-payment account number based on the user’s mobile telephone number” are not necessary because the prior art teaches a scenario in which the customer does not have sufficient funds.

Assuming, for purposes of moving prosecution forward, that this is an assertion that the limitations are inherent in the prior art due to its teaching regarding that scenario, Applicant respectfully disagrees. Just because the Hultgren teaches as an optional feature, an ability to assure that the customer account has sufficient funds to cover the transaction amount prior to effecting the transaction (col. 7, lines 18-20), does not mean that all of the limitations claims, e.g., “prompting, via the vending machine, the user to select a merchandise item, generating a billing entry and settling the billing entry via a payment gateway,...” must necessarily be present in the disclosed device. Without such necessary presence, the claimed limitations are not inherent in the prior art patent.

Moreover, all of the independent claims now recite that a request is issued, with a reference to the vending machine, to reserve a certain maximum amount from the account of the user who has been uniquely identified based on his telephone number. There is no teaching in the cited art that a maximum amount of money is to be reserved from a user's bank account in a bank. This limitation was present in, e.g., original claim 4, and the Office Action asserted that with respect to this limitation, the limitations are not required. For the reasons discussed above, this assertion is incorrect. It is certainly possible that the system of Hultgren could be implemented without a reservation of a maximum amount of money. Unless such a feature is necessarily present in the prior art, it is not inherent in the prior art.

Stewen discloses a system in which charges for items received from a vending machine or other service apparatus, are applied to a user's mobile telephone account, and thereafter appear on the mobile telephone bill.

Further, Applicant respectfully submits it only with impermissible hindsight reference to Applicant's disclosure would one of ordinary skill in the art have found it obvious to modify Hultgren to include the teaching of Stewen to yield Applicant's claimed invention. There is nothing in Hultgren that would have suggested to one of ordinary skill in the art that a bank account could be debited for the purchase price of the item sold in a vending machine, or that Hultgren's system could be modified to implement such a method.

For at least these reasons, Applicant respectfully submits that claims 1, 10 and 18 are patentable over the prior art of record. Claims 2-9, 11-17, and 19-20 depend from and include the recitations of claims 1, 10, and 18. Applicant respectfully submits that

Appln. No. 10/089,253
Amdt. dated August 11,2008
Reply to Office action of September 9, 2008

claims to-9, 11-17, and 19-20 are patentable in and of themselves and as they depend from and include the recitations of claims 1, 10, and 18, which are patentable for the reasons discussed above.

In view of the above amendment and remarks, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections of record. Applicant submits that the application is in condition for allowance and early notice to this effect is most earnestly solicited.

If the Examiner has any questions, he is invited to contact the undersigned at
202-628-5197

Respectfully submitted,

BROWDY AND NEIMARK, P.L.L.C.
Attorneys for Applicant(s)

By /Ronni S. Jillions/
Ronni S. Jillions
Registration No. 31,979

RSJ:me
Telephone No.: (202) 628-5197
Facsimile No.: (202) 737-3528
G:\BN\R\rieb\Langer1\PTO\2008-08-11Amendment.doc